



**UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/315,852	09/30/94	BARRIE	8 604291

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12M2/0524

EXAMINER BOTTINI, S	
ART UNIT	PAPER NUMBER
	13

DATE MAILED: 1202

05/24/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/315,882

Applicant(s)

Barrie et al.

Examiner

Anthony Bottino

Group Art Unit

1202



☐ Responsive to communication(s) filed on _____

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 3-9, 11-16, 18, 19, 21-25, 35, and 36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 3-9, 11-16, 18, 19, 21-25, 35, and 36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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I. This action is in response to applicant's amendment of 2/20/96.

1) **Claims 1,2,10,17,20** has been cancelled by applicant's amendment.

2) **Claims 3-9,11-16,18-19,21-25,35-36** are currently pending.

3) **Claims 3-9,11-16,18-19,21-25,35-36** are currently rejected for the reasons states in the last office action.

II. The following rejections are withdrawn:

i) **Claims 1-25** previously rejected under 35 U.S.C. § 112 first and second paragraph. This rejection is withdrawn.

Applicant has further defined and limited the definition of 'X' such that the specification would be enable one of ordinary skill in the art in how to make and use the instant invention.

III. The following rejections are maintained:

i) **Claims 3-9,11-16,18-19,21-25,35-36** are rejected under 35 U.S.C. § 103 as being unpatentable over **Wicha et al**(AR reference). This rejection is maintained for the reasons stated in the previous office action.

a) Applicant's arguments filed 3/12/96 have been fully considered but they are not deemed to be persuasive. Applicant

argues that the Wicha reference does not provide all the essential elements claimed in for the instant compounds.

To elaborate on the previous action and to make the record clear, examiner has determined that the prior art, Wicha, renders obvious the claims of the instant invention by teaching a compound which embraces applicant's claimed compounds, specifically compound 11 page 21. While compound 11 has been excluded from the claims for 102 purposes, the instant compounds are structural homologs of the reference compound. One having ordinary skill in the art would have been motivated to prepare the instantly claimed invention because such structurally homologous compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. **In re Hass**, 60 USPQ 544 (CCPA 1944); **In re Henze**, 85 USPQ 261 (CCPA 1950). Note the instant invention's compounds are nonobvious with respect to the reference compound 3 (final product). However, the instant invention's compound are obvious with respect to the reference intermediate compound 11, as stated above, this intermediate is isolated by the reference, and is structurally related to a product having physiological activity. Applicant has the burden of establishing that the claimed invention has unexpected results over the prior art compound 11 in Wicha, thus, applicant's 132 affidavit comparing

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the instant compounds to the nonobvious compound 3 is not evidence sufficient to overcome the obviousness rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

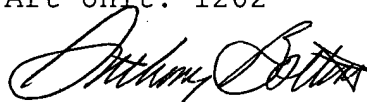
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Bottino whose telephone number is (703) 305-6335. This Examiner can normally be reached on Monday-Friday from 9:00 AM to 5:00 PM. If this Examiner is not at his desk, please leave a message; and he will return your call as soon as possible.

The FAX phone number for this Group 1202 is (703) 308-4734. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

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Anthony P. Bottino
May 20, 1996



MUKUND J. SHAH
SUPERVISORY PATENT EXAMINER
GROUP 1200